

**REMARKS**

In the present Amendment, claim 12 has been added. Support for claim 12 may be found, for example, in claim 7.

No new matter has been added and entry of the Amendment is respectfully requested. Upon entry of the Amendment, claims 2-12 will be all the claims pending in the application.

Claims 2-11 have been rejected under 35 U.S.C. § 103(a) as allegedly being unpatentable over either JP Abstract 11-166164 or Applicants' alleged admissions, each taken in view of the English translation of JP 09-208910.

Applicants note that it is stated in the Office Action dated July 29, 2004, that the rejection is based on JP Abstract '164 or "Applicants' admissions" in view of JP '910, JP 07-026223 and JP 04-292943 are also relied upon in the Examiner's reasoning in support of the rejection.

Specifically, JP '223 is relied upon by the Examiner as disclosing that an antistatic agent can be incorporated into the base layer, coated on the base film or incorporated into the adhesive layer. JP '943 is relied upon by the Examiner as disclosing coating a self-adhesive layer containing an antistatic agent onto a thermoplastic resin base film.

Applicants respectfully traverse the rejection for at least the following reasons.

1. **JP '223**

JP '223 discloses a protecting film comprising an antistatic layer, a base film and an adhesive layer in this order, and a base film, an antistatic layer and an adhesive layer in this order (paragraphs [006] and [007], claims and examples).

However, JP '223 does not disclose or suggest an adhesive layer incorporated therein an antistatic agent, as alleged by the Examiner. Accordingly, Applicants respectfully submit that

even if there might be motivation to combine the cited references, the combination would not be the present invention, where at least one selected from the group consisting of inorganic conductive materials, organic antistatic agents and organic conductive materials is contained in the heat-expandable pressure-sensitive adhesive layer, as recited in present independent claim 3.

Further, present claim 3 recites “A heat-peelable pressure-sensitive adhesive sheet comprising a substrate and formed on at least one side thereof a heat-expandable pressure-sensitive adhesive layer ... and wherein at least one selected from the group consisting of inorganic conductive materials, organic antistatic agents and organic conductive materials is ... applied to the heat-expandable pressure-sensitive adhesive layer.” It is implicit that, in the present invention, a substrate, an adhesive layer and a layer containing one of the recited specie are arranged in this order.

In contrast, as noted above, the protecting film of JP ‘223 comprises an antistatic layer, a base film and an adhesive layer in this order, or a base film, an antistatic layer and an adhesive layer in this order. These structures are different from the structure of the presently claimed heat-peelable pressure-sensitive adhesive film.

Accordingly, Applicants respectfully submit that even if there might be motivation to combine the cited references, the combination would not be the present invention, where at least one selected from the group consisting of inorganic conductive materials, organic antistatic agents and organic conductive materials is applied to the heat-expandable pressure-sensitive adhesive layer.

2. JP '943

JP '943 discloses incorporating an antistatic agent in an adhesive layer. However, JP '943 does not disclose or suggest applying an antistatic agent to an adhesive layer or a film comprising a substrate, an adhesive layer and an antistatic layer in this order.

Further, the present claims recite that “the heat-expandable pressure-sensitive adhesive layer before heating has a maximum surface roughness of 5  $\mu\text{m}$  or less.” Applicants respectfully submit that when the surface roughness value increases, the contact area between an adherend and the surface of a pressure-sensitive adhesive decreases. As a result, lifting tends to generate. Therefore, in order to increase conductive efficiency and to uniformly obtain the antistatic effect on the entire surface, high adhesion between an adherend and the surface of a pressure-sensitive adhesive must be secured. The cited references do not disclose or suggest these advantages of the present invention.

In view of the foregoing reasons, Applicants respectfully submit that the present invention is not obvious over the cited references and the rejection should be withdrawn.

In view of the above, reconsideration and allowance of this application are now believed to be in order, and such actions are hereby solicited. If any points remain in issue which the Examiner feels may be best resolved through a personal or telephone interview, the Examiner is kindly requested to contact the undersigned at the telephone number listed below.

AMENDMENT UNDER 37 C.F.R. § 1.111  
U.S. Application No.: 09/853,787

Attorney Docket Q64434

The USPTO is directed and authorized to charge all required fees, except for the Issue Fee and the Publication Fee, to Deposit Account No. 19-4880. Please also credit any overpayments to said Deposit Account.

Respectfully submitted,



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**23373**

CUSTOMER NUMBER

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